

SUPPORT FOR THE AMENDMENTS

Claims 1-11, 13-19 and 21-23 are amended to use wording and structure consistent with U. S. patent law practice.

Support for the amendment of Claim 1 is found on page 7, lines 4-5, in the specification.

Support for the amendment of Claim 9 is found on page 10, line 9, in the specification.

Claim 10 is rewritten to be an independent claim including all the limitations of the base claim and any intervening claims.

Claims 24 and 25 are herein canceled.

No new matter is believed added to this application by entry of this amendment.

Upon entry of this amendment, Claims 1-23 are active.

REMARKS/ARGUMENTS

The claimed invention is directed to a composition containing inorganic oxidic powders having a size as small as a nanometer range which is compatible with and useful for incorporating the powders into alkoxysilane formulations and products. A composition which is stable, readily dispersible, provides a homogeneous mixture and has a low viscosity is sought.

The claimed invention addresses this problem by providing the formulation according to Claim 1 and claims dependent thereon and the process for preparing the formulation according to Claim 10 and claims dependent thereon. Applicants note that Claim 1 is herein amended to describe a formulation containing (i) at least one organoalkoxysilane and/or at least one organoalkoxysiloxane; (ii) at least one inorganic oxidic powder; and (iii),

optionally, an organic or inorganic acid. The content of the claimed formulation is from 5 to 50% by weight inorganic oxidic powder and a weight ratio of the at least one organoalkoxysilane and/or at least one organoalkoxysiloxane to the at least one inorganic oxidic powder is from 19:1 to 1:1. The viscosity of the formulation is less than 1500 mPa.s. No such formulation is disclosed or suggested by the cited reference.

The rejection of Claims 1-9 under 35 U.S.C. 102(b) or, in the alternative, under 103(a) over Chapman et al. (U.S. 2003/0181566) is respectfully traversed.

Chapman describes a metal oxide particle formulation containing a binder which is useful as a coating for paper and films (Abstract). The inorganic oxide particles can be surface treated [0089]. The Office has pointed to Example XIII and alleged that the description of the example renders the invention of Claim 1 obvious (Official Action dated October 1, 2009, page 4, lines 1-11).

In Example XIII, Chapman describes a surface modification treatment of a porous silica gel with 3-Aminopropyltriethoxysilane. 0.5g of the 3-Aminopropyltriethoxysilane is added to 10g (50 g “as is” at 20% solids) of the porous silica gel. Therefore, **the weight ratio described is 0.5/10 or 0.05.**

In contrast, the weight ratio of the at least one organoalkoxysilane and/or at least one organoalkoxysiloxane to the at least one inorganic oxidic powder according to Claim 1 is from 19:1 to 1:1. This Chapman ratio is significantly less than the claimed weight ratio range. Nowhere does the reference disclose a formulation having the composition according to Claim 1.

Applicants respectfully submit that a proper finding of anticipation requires that “[e]very element of the claimed invention ... be literally present, arranged as in the claim. *Perkin-Elmer Corp.*, 732 F.2d at 894, 221 USPQ at 673; *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 [224

USPQ 520] (1984). The identical invention must be described in as complete detail in the reference as is described in the claimed invention.

As Chapman nowhere discloses a formulation having a weight ratio of at least one organoalkoxysilane and/or at least one organoalkoxysiloxane to at least one inorganic oxidic powder being in the range of from 19:1 to 1:1, Applicants submit that the cited reference cannot anticipate the invention according to Claim 1.

Moreover, nowhere does Chapman suggest or provide motivation that would have led one of ordinary skill in the art at the time of the present invention to the claimed formulation. Applicants note that the reference does not disclose or suggest a binder being an organoalkoxysilane or an organoalkoxysiloxane [0090], much less providing any motivation that would have served as guidance to one of ordinary skill in the art for the claimed weight ratio range.

In view of all the above, Applicants submit that the cited reference can neither anticipate nor render the claimed invention according to Claim 1 and claims dependent thereon, obvious. Accordingly, Applicants respectfully request that the rejection of Claims 1-9 under 35 U.S.C. 102(b) or, in the alternative, under 103(a) over Chapman be withdrawn.

Applicants wish to thank Examiner Collins for the indication that Claims 10-20 would be allowed, if Claim 10 were rewritten as an independent claim including all the limitations of the base claim and any intervening claims. Applicants respectfully note that Claim 10 is rewritten as an independent claim, as required, herein. Accordingly, Claims 10-20 are believed to be in condition for allowance.

The rejections of Claims 21-25 under 35 U.S.C. 101 and under 35 U.S.C. § 112, second paragraph are believed obviated by appropriate amendment. Claims 24 and 25 are herein canceled and Claims 21-23 are rewritten to use wording and structure consistent with U.S. patent law practice. Accordingly, withdrawal of the rejections is respectfully requested.

Application No. 10/563,022  
Reply to Office Action of October 1, 2009

The objection to Claim 13 is believed obviated by appropriate amendment. The typographical error noted by the Office is herein corrected. Withdrawal of the objection is respectfully requested.

An Abstract is attached herewith.

Applicants respectfully submit that the above-identified application is now in condition for allowance and early notice of such action is earnestly solicited.

Respectfully submitted,

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